REMARKS

The Office Action mailed October 8, 2009 (hereinafter, "Office Action") has been reviewed and the Examiner's comments considered. Claims 1-60 are pending in this application. Claims 28-60 are withdrawn. Claim 1 is amended herein. Applicants submit that no new matter or issues have been introduced.

Claim Rejections - 35 U.S.C. § 112

Claims 1-27 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action states that "[c]laim 1 recites the limitation 'the blocking member' in line 12" and that "[t]here is insufficient antecedent basis for this limitation in the claim." Without conceding the propriety of the rejection, in the interest of compact prosecution, claim 1 has been amended to recite "the drag force and a blocking member cause rotation of the binding member" rather than "the drag force and blocking member causing rotation of the binding member." Accordingly, Applicants request favorable reconsideration and withdrawal of this rejection under 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 U.S.C. § 102

Claims 1-13 and 15 -27 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over USPN 5,697,907 to Gaba (hereinafter, "Gaba"). Applicants respectfully traverse this rejection.

Amended independent claim 1 recites, *inter alia*, a "binding member including at least one drag inducing member such that the at least one drag inducing member engages the needle during slidable receipt of the needle to create a drag force with the needle, the drag force providing substantially all of the energy for movement such that the drag force and a blocking member cause rotation of the binding member relative to a longitudinal axis of the needle such that the binding surfaces engage the needle to prevent slidable movement of the needle in the extended position of the shield, the binding member further including a needle communicating surface extending

therefrom such that the needle communicating surface is engageable with the needle to prevent rotation of the binding member."

The Office Action alleges that "the blocking member (352) very clearly causes rotation, see Fig 14. The drag inducing members (356, 358, 364) also cooperate with the blocking member by virtue of their mechanical connections to cause at least some rotation of the binding member." (Office Action, p. 4.) Applicants respectfully disagree.

First, a spring is indicated by reference character 352, not a blocking member. Thus, Applicants agree that the spring 352 "very clearly causes rotation" in the cited reference. (*See* Gaba, FIG. 14.) The claimed blocking member does not store energy.[1] Instead, the blocking member blocks movement in one direction so as to direct a drag force such that "[t]he drag force in conjunction with one of blocking members 116 and/or 117, cause binding member 105 to move to a binding position." Accordingly, "the force created by blocking members 116 and/or 117 acts in a direction opposite to the drag force." (*See* Instant Application, p.12, lines 12-15, and FIG. 4). On the contrary, in Gaba, the spring stores energy and causes the rotation. (As the Office Action admits the spring 352 "very clearly causes rotation.") The spring 352 does not block movement in one direction such that frictional forces with the needle acting in the opposite direction can cause rotation.

Regarding reference character 358, an arm of the retainer 348 is indicated rather than a drag inducing member "to create a drag force with the needle" as recited in claim 1. Arm 358 does not contact the needle; accordingly, it cannot "create a drag force with the needle." (*See* FIGS. 13 and 14, retainer 348 is stopped by housing 342 before contacting the needle.) Further, even if arm 358 did contact the needle, any frictional force created by the motion of the needle would operate opposite the direction of rotation. Regarding reference character 364, a front hole 364 is indicated, rather than a drag inducing member. The front hole 364 does not "create a drag force with the needle" such that "the drag force and a blocking member [cause] rotation" because if the needle is

[1] A spring is commonly known to be a type of energy storage element.

in contact with front hole 364 the retainer 348 cannot rotate because the needle position in the front hole 364 keeps rotation from occurring.

As stated in Gaba, "[t]he spring 352 shifts the retainer 348 into the position shown in FIG. 14. In this position, the point 135 of the needle cannot be pushed forward and out of the housing 344, as it is blocked by the front leg 360 of the retainer 348. The needle may not be withdrawn further from the housing 344, as the rear leg 356 frictionally locks against the needle." (Gaba, col. 5:67 to col. 6:6, emphasis added). Accordingly, with respect to reference character 362, friction between rear hole 362 and the needle locks the needle, such that movement cannot occur. The frictional forces do not "create a drag force with the needle" such that "the drag force and a blocking member [cause] rotation" as recited in claim 1.

Even assuming, *arguendo*, that some friction between the bottom of the needle and the bottom of rear hole 362 occurs after the needle is removed from front hole 364 and before rear hole 362 is positioned to lock the needle, this does not provide "substantially all of the energy for movement" to *cause* the rotation. Because of spring 352 the rotation will occur whether or not any friction is present between the bottom of the needle and the bottom of rear hole 362.

Accordingly, Applicants reiterate the arguments from the previous response with respect to Gaba, filed July 7, 2009. Gaba shows and described a safety catheter the includes a retainer 348 that includes "a hook 354 extending out of the housing 344 to engage and hold the catheter to the housing. A spring 352 urges the retainer 348 to the rear of the housing." (Gaba, col. 5, ll. 52-55, emphasis added). As can be seen in Gaba, FIG. 14 (reproduced below), when the point 135 of the needle 132 clears the front hole 364 the spring 352 (not frictional force) "urge" the retainer 348 movement. While drag will occur wherever the needle 132 contacts the front hole 364 or the rear hole 362 while the needle 132 is moving, the design of Gaba does not harness this drag to cause "rotation of the binding member relative to a longitudinal axis of the needle such that the binding surfaces engage the needle to prevent slidable movement of the needle in the extended position of the shield" as required by claim 1. Differently, Gaba shows and describes a spring 352 that causes the retainer 348 to move, i.e., to urge the retainer 348. (Gaba, col. 5, ll. 54-55).

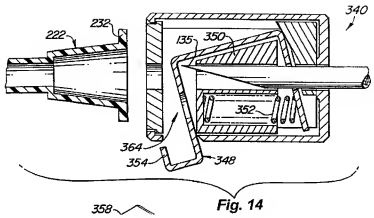

Fig. 14

According to the MPEP, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." (MPEP § 2131). Gaba does not provide any showing or description of the claimed drag force and shield causing rotation of the binding member using drag forces, and therefore Gaba does not anticipate independent claim 1.

Accordingly, in view of the above, independent claim 1 is patentable over Gaba as Gaba does not show or describe each of the limitations thereof. Dependent claims 2-13 and 15-27 are patentable because they depend from a patentable independent claim, and also because they recite features not shown or described by the cited art. Therefore, Applicants request favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 102.

Claim Rejections - 35 U.S.C. § 103

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaba in view of USPN 4,978,344 to Dombrowski et al. (hereinafter "Dombrowski"). Applicants respectfully traverse this rejection.

Without conceding the propriety of the asserted combination, or the assertions made in the Office Action with respect to the allegedly disclosed subject matter, Applicants submit that claim 14 depends from patentable independent claim 1, in view of the above, and is therefore patentable.

Accordingly, Applicants request favorable reconsideration and withdrawal of this rejection under 35 U.S.C. § 103.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

It is noted that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between the cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein should not be construed to prejudice or foreclose future consideration by Applicants of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner and/or the merits of additional or alternative arguments.

Applicants believe no fee is due with this submission. However, if a fee is due, please charge our Deposit Account No. 50-2191, under Order No. 101673.0057P4 from which the undersigned is authorized to draw.

Dated: January 8, 2010

Respectfully submitted,

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